



\$ AF 1632

PTO/SB/21 (08-03)

Approved for use through 08/30/2003. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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| | | |
|---|------------------------|----------------------|
| TRANSMITTAL FORM (to be used for all correspondence after initial filing) | Application Number | 10/010,065 |
| | Filing Date | December 5, 2001 |
| | First Named Inventor | Keith D. ALLEN |
| | Art Unit | 1632 |
| | Examiner Name | Bertoglio, Valerie E |
| Total Number of Pages in This Submission | Attorney Docket Number | R-648 |

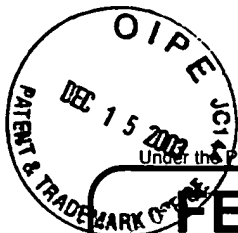
| ENCLOSURES (Check all that apply) | | |
|--|---|---|
| <input checked="" type="checkbox"/> Fee Transmittal Form | <input type="checkbox"/> Drawing(s) | <input type="checkbox"/> After Allowance communication to Technology Center (TC) |
| <input type="checkbox"/> Fee Attached | <input type="checkbox"/> Licensing-related Papers | <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences |
| <input checked="" type="checkbox"/> Amendment/Reply | <input type="checkbox"/> Petition | <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) |
| <input checked="" type="checkbox"/> After Final | <input type="checkbox"/> Petition to Convert to a Provisional Application | <input type="checkbox"/> Proprietary Information |
| <input type="checkbox"/> Affidavits/declaration(s) | <input type="checkbox"/> Power of Attorney, Revocation | <input type="checkbox"/> Status Letter |
| <input type="checkbox"/> Extension of Time Request | <input type="checkbox"/> Change of Correspondence Address | <input type="checkbox"/> Other Enclosure(s) (please identify below): |
| <input type="checkbox"/> Express Abandonment Request | <input type="checkbox"/> Terminal Disclaimer | RECEIVED DEC 19 2003 TECH CENTER 1600/2900 |
| <input type="checkbox"/> Information Disclosure Statement | <input type="checkbox"/> Request for Refund | |
| <input type="checkbox"/> Certified Copy of Priority Document(s) | <input type="checkbox"/> CD, Number of CD(s) _____ | |
| <input type="checkbox"/> Response to Missing Parts/Incomplete Application | Remarks | |
| <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | | |

| SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT | |
|--|-------------------|
| Firm or Individual name | Kelly L. Quast |
| Signature | Kelly L. Quast |
| Date | December 10, 2003 |

| CERTIFICATE OF TRANSMISSION/MAILING | | |
|---|----------------|---------------|
| I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below. | | |
| Typed or printed name | Kelly L. Quast | |
| Signature | Kelly L. Quast | Date 12/10/03 |

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$)**55.00**

Complete if Known

Application Number **10/010,065**
Filing Date **December 5, 2001**
First Named Inventor **Keith D. ALLEN**
Examiner Name **Bertoglio, Valerie E**
Art Unit **1632**
Attorney Docket No. **R-648**

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

Deposit Account Number **50-1271**
Deposit Account Name **Deltagen, Inc.**

The Director is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Credit any overpayments

☐ Charge any additional fee(s) or any underpayment of fee(s)

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

| Large Entity | | Small Entity | | Fee Description | Fee Paid |
|--------------|----------|--------------|----------|------------------------|----------|
| Fee Code | Fee (\$) | Fee Code | Fee (\$) | | |
| 1001 | 770 | 2001 | 385 | Utility filing fee | |
| 1002 | 340 | 2002 | 170 | Design filing fee | |
| 1003 | 530 | 2003 | 265 | Plant filing fee | |
| 1004 | 770 | 2004 | 385 | Reissue filing fee | |
| 1005 | 160 | 2005 | 80 | Provisional filing fee | |
| SUBTOTAL (1) | | | | | (\$) |

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims -20** = X =
Independent Claims -3** = X =
Multiple Dependent =

| Large Entity | | Small Entity | | Fee Description | Fee Paid |
|--------------|----------|--------------|----------|--|----------|
| Fee Code | Fee (\$) | Fee Code | Fee (\$) | | |
| 1202 | 18 | 2202 | 9 | Claims in excess of 20 | |
| 1201 | 86 | 2201 | 43 | Independent claims in excess of 3 | |
| 1203 | 290 | 2203 | 145 | Multiple dependent claim, if not paid | |
| 1204 | 86 | 2204 | 43 | ** Reissue independent claims over original patent | |
| 1205 | 18 | 2205 | 9 | ** Reissue claims in excess of 20 and over original patent | |
| SUBTOTAL (2) | | | | | (\$) |

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

| Large Entity | | Small Entity | | Fee Description | Fee Paid |
|--------------|----------|--------------|----------|--|----------|
| Fee Code | Fee (\$) | Fee Code | Fee (\$) | | |
| 1051 | 130 | 2051 | 65 | Surcharge - late filing fee or oath | |
| 1052 | 50 | 2052 | 25 | Surcharge - late provisional filing fee or cover sheet | |
| 1053 | 130 | 1053 | 130 | Non-English specification | |
| 1812 | 2,520 | 1812 | 2,520 | For filing a request for ex parte reexamination | |
| 1804 | 920* | 1804 | 920* | Requesting publication of SIR prior to Examiner action | |
| 1805 | 1,840* | 1805 | 1,840* | Requesting publication of SIR after Examiner action | |
| 1251 | 110 | 2251 | 55 | Extension for reply within first month | 55.00 |
| 1252 | 420 | 2252 | 210 | Extension for reply within second month | |
| 1253 | 950 | 2253 | 475 | Extension for reply within third month | |
| 1254 | 1,480 | 2254 | 740 | Extension for reply within fourth month | |
| 1255 | 2,010 | 2255 | 1,005 | Extension for reply within fifth month | |
| 1401 | 330 | 2401 | 165 | Notice of Appeal | |
| 1402 | 330 | 2402 | 165 | Filing a brief in support of an appeal | |
| 1403 | 290 | 2403 | 145 | Request for oral hearing | |
| 1451 | 1,510 | 1451 | 1,510 | Petition to institute a public use proceeding | |
| 1452 | 110 | 2452 | 55 | Petition to revive - unavoidable | |
| 1453 | 1,330 | 2453 | 665 | Petition to revive - unintentional | |
| 1501 | 1,330 | 2501 | 665 | Utility issue fee (or reissue) | |
| 1502 | 480 | 2502 | 240 | Design issue fee | |
| 1503 | 640 | 2503 | 320 | Plant issue fee | |
| 1460 | 130 | 1460 | 130 | Petitions to the Commissioner | |
| 1807 | 50 | 1807 | 50 | Processing fee under 37 CFR 1.17(q) | |
| 1806 | 180 | 1806 | 180 | Submission of Information Disclosure Stmt | |
| 8021 | 40 | 8021 | 40 | Recording each patent assignment per property (times number of properties) | |
| 1809 | 770 | 2809 | 385 | Filing a submission after final rejection (37 CFR 1.129(a)) | |
| 1810 | 770 | 2810 | 385 | For each additional invention to be examined (37 CFR 1.129(b)) | |
| 1801 | 770 | 2801 | 385 | Request for Continued Examination (RCE) | |
| 1802 | 900 | 1802 | 900 | Request for expedited examination of a design application | |

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$)**55.00**

SUBMITTED BY

Name (Print/Type) **Kelly L. Quast** Registration No. **52,141** Telephone **(650) 569-5100**
Signature **Kelly L. Quast** Date **12/10/03**

WARNING: Information on this form may become public. Credit card information should not be included in this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/010,065 | 12/05/2001 | Keith D. Allen | R-648 | 2751 |

7590 08/13/2003

DELTAGEN, INC.
740 Bay Road
Redwood City, CA 94063

EXAMINER

BERTOGLIO, VALARIE E

ART UNIT PAPER NUMBER

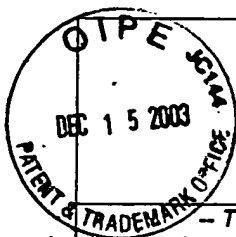
1632

IS

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

RESP DUE 11.13.03
RECEIVED
AUG 21 2003
BY: [Signature]



Office Action Summary

Application No.

10/010,065

Applicant(s)

ALLEN ET AL.

Examiner

Valarie Bertoglio

Art Unit

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-4, 11-17 and 35-71 is/are pending in the application.
- 4a) Of the above claim(s) 1-4, 11-17 and 35-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 57-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 12.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Response to Amendment

Applicant's arguments filed 04/14/2003, paper number 12, have been fully considered. Claims 5-10 and 18-34 have been cancelled. Claims 57-71 have been added. Claims 1-4, 11-17 and 35-56 have been withdrawn. Claims 1-4, 11-17, 35-71 are pending and claims 57-71 are under consideration in the instant action.

Specification

Applicants arguments to the objection to the specification on the grounds that the specification is unclear as to the phenotype of the claimed mice with regard to fasting blood glucose levels has been considered and was not found persuasive. The statement on page 62, lines 28-30 of the specification, disclosing that heterozygous mutant mice display decreased fasting glucose levels is contradictory to the statement on page 59, line 12 disclosing that heterozygous mutant mice have increased fasting blood glucose levels. Figure 4 supports the statement that heterozygous mutant mice had increased blood glucose levels. Applicants respond that Table 2 does not refer to fasting glucose levels but non-fasting glucose levels. However, the relevance of this argument is unclear. Examiner's explanation of the lack of clarity of the specification with regard to the phenotype of the mouse did not rely on Table 2. Applicants' response also gives evidence that heterozygous mice display reduced serum non-fasting glucose levels (page 4, lines 24-29), however, they fail to address the fact that the specification states that "heterozygous mutant mice had increased fasting blood glucose levels." (page 59, line 12-page 60, line 1). With evidence in the specification to support contradictory phenotypes, it cannot be determined which phenotype(s) the mice actually displayed.

Claim Rejections - 35 USC § 112, 1st paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 57-71 as newly added are rejected under 35 U.S.C 112, 1st paragraph as containing subject matter which was not described in the specification in such a way as to reasonably enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 5-10 and 18-34 have been cancelled and thus, the rejection as it pertains to claims 5-10 and 18-34 is withdrawn. The previous rejection is, however, applicable to claims 57-71 for the reasons of record advanced on pages 7 and 8 of the previous office action mailed 01/07/2003. For clarity, the rejection is reiterated below.

1) The specification fails to enable knocking out any glucagon receptor gene other than that set forth by SEQ ID NO:1 (see page 8, 2nd paragraph of prior office action mailed 01/07/2003).

By use of the phrase "an endogenous glucagon receptor gene", claims 57 and 70, are drawn to any glucagon receptor gene, including orthologues of the mouse glucagon receptor set forth by SEQ ID NO:1. The specification only teaches one mouse glucagon receptor gene (SEQ ID NO: 1; page 10, lines 6-8). The specification does not provide adequate guidance for determining other mouse glucagon receptor genes or that other glucagon receptor genes exist in mouse or have the same function as the glucagon receptor gene disclosed. Therefore, a knockout of any glucagon receptor gene other than the glucagon receptor described in the specification would have different phenotypic effects that are not predictable (see pages 5-6 of the prior office action). Deleting the word "an" preceding the term "endogenous" in claims 57 and 70 would overcome this rejection.

2) The specification fails to enable making mice comprising a homozygous and/or heterozygous disruption of the glucagon receptor gene wherein the mice exhibit any phenotype

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(see page 5, paragraph 2; page 7, paragraph 2; page 8, paragraph 1 of prior office action mailed 01/07/2003).

Claim 57 encompasses mice heterozygous for a disruption in the glucagon receptor gene wherein the mice have any phenotype. The phrase, "A transgenic mouse whose genome comprises a disruption in an endogenous glucagon receptor gene" encompasses both homozygous and heterozygous mice. The following phrase of the claim, "wherein where the disruption is homozygous, the transgenic mouse exhibits, relative to a wild-type mouse, a metabolic abnormality or a pancreatic abnormality" limits the recited phenotype to homozygous mice only. Therefore, the heterozygous mice encompassed by the claim have no recited phenotype and therefore, encompasses mice heterozygous for a disruption in the glucagon receptor gene wherein the mouse has any phenotype.

The specification teaches that mice heterozygous for a disruption in the glucagon receptor gene display both increased fasting blood glucose levels (sentence bridging pages 59-60) and decreased fasting glucose levels (page 62, lines 28-30), increased fasting insulin levels (Figure 11), reduced non-fasting serum glucose levels (page 59, line 2; Table 2) and mild to moderate hyperplasia and hypertrophy of the islet cells (page 56, lines 20-21). Therefore, the specification is enabling for heterozygous mice having only those phenotypes as described by the specification. As set forth in the art and described in said prior office action (page 5, paragraph 2), the phenotype of a transgenic animal was unpredictable at the time of filing. The specification does not overcome the unpredictability inherent in generating knockout mice such that any phenotype could be obtained and its use determined prior to learning the phenotype. The specification does not teach any phenotype for the claimed heterozygous mice other than those listed above. Without reciting a phenotype in claim 57 for the heterozygous mice, the claim encompasses heterozygous mice with other phenotypes not supported by the

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specification. Without guidance as to how to obtain and use the heterozygous mice, it would require one of skill in the art at the time the invention was made, undue experimentation to determine how to obtain any phenotype in a mouse heterozygous for a disruption in the glucagon receptor gene or to use said mouse wherein the mouse has any phenotype.

Claim 70 encompasses a transgenic mouse whose genome comprises a homozygous disruption in an endogenous glucagon receptor gene wherein the mouse has any phenotype. There is no phenotype recited for the claimed mouse. The phenotype of reduced fertility recited in line 5 of the claim is the phenotype of the offspring of the claimed mouse and does not reflect any observable or detectable phenotype of the claimed mouse that correlates to the disruption in the glucagon receptor gene. The specification fails to overcome the unpredictability in the art as set forth above and in the prior office action. Accordingly, it would require one of skill in the art at the time the invention was made, undue experimentation to determine how to make and use the claimed mouse having any phenotype.

Claims 58-69 depend from parent claim 57 and also encompass both the homozygous heterozygous mice encompassed by the parent claim. Accordingly, the above rejection also applies to claims 58-69.

Claim 71 depends from parent claim 70 and also encompasses both the homozygous heterozygous mice encompassed by the parent claim. Accordingly, the above rejection also applies to claim 71.

Applicants argue that the rejections reiterated above are overcome by limitations introduced to newly added claims 57-71. This argument is not persuasive. Applicants' do not address how newly added claims 57 and 70 overcome the rejection to the broad genera of glucagon receptor genes encompassed by the phrase "an endogenous glucagon receptor". Applicants' also argue that the specification is fully enabling for the newly added claims as they

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are limited to specific phenotypes. However, claim 57 is written such that it encompasses a heterozygous mouse exhibiting any phenotype. Claims 58-69 and 71 are dependent from claim 57 and encompass both heterozygous and homozygous mice wherein the mice have specific phenotypes. However, the phenotypes cited by claims 59-63, 65-69 are not supported by the specification. Furthermore, the homozygous mouse of claim 70 does have a phenotype. Therefore, applicants' arguments with respect to claims 57-71 are not persuasive the rejections reiterated above are maintained for the reasons of record.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Valarie Bertoglio whose telephone number is 703-305-5469. The examiner can normally be reached on Mon-Weds 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds can be reached on 703-305-4051. The fax phone numbers for

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the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

PETER PARAS
PATENT EXAMINER

A handwritten signature in cursive script, appearing to read "Pete Paras", written in black ink.

Valarie Bertoglio
Examiner
Art Unit 1632



Intervi w Summary

Application No.

10/010,065

Applicant(s)

ALLEN ET AL.

Examiner

Valarie Bertoglio

Art Unit

1632

All participants (applicant, applicant's representative, PTO personnel):

(1) Valarie Bertoglio.

(3) _____

(2) Nicole Verona.

(4) _____

Date of Interview: 02 June 2003.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☐ No.

If Yes, brief description: _____

Claim(s) discussed: 57-85.

Identification of prior art discussed: _____

Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

PETER PARAS
PATENT EXAMINER

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.


Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Faxed amendments were not in compliance with Rule 1.121. The amendments faxed 06/10/2003 (which was also mailed), paper #13 and 06/17/2003, paper #14, failed to list the status of claims 1-56. Ms. Verona agreed to send in a new amendment in compliance with Rule 1.21 that reflects the claims as listed in the non-entered amendments (paper # 13 and 14), in light of the last officially entered amendment received 04/14/2003, paper #12. As of 07/08/2003, no amendment has been received and a FINAL office action will be mailed.